



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,819	06/25/2001	Robin S. Gray		9738

7590 04/22/2005
ROBIN S. GRAY
3538 SPLIT RAIL LANE
ELLCOTT CITY, MD 21042

EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
----------	--------------

2675

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,819

Applicant(s)

GRAY, ROBIN S.

Examiner

Ming-Hun Liu

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 21, 22, 24, 25, 27, 28, 29, 33 and 34 are allowed is/are allowed.
- 6) ☒ Claim(s) 6-9, 11-18-20, 23, 26 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Allowable Subject Matter

1. Independent claim 1, and corresponding dependent claims 2-5, 21, 22, 24, 25, 27, 28, 29, 33 and 34 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The examiner agrees with the applicant's arguments concerning independent claim 1 as outlined in page 8 of the applicant's response to final office action.

2. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 6, 7, 12, 26, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,489,948 to Lau.

In reference to claims 6, 7 and 31 Lau teaches an auxiliary computer mouse (figure 1A), wherein said auxiliary computer mouse comprises a computer mouse housing supporting at least

Art Unit: 2675

one mechanical mouse button (108 and 110), and at least one (separate from the mouse button) touch pad (106), said mechanical mouse button being movably mounted within said mouse housing and capable of independent movement relative to said mouse housing to invoke a highlighting mode without physical movement of said mouse housing (column 4, lines 1-11).

In reference to claim 12, it can be seen from figure 1A that the mouse is separate from a CPU housing and keyboard housing.

In reference to claim 26, as thought by Lau in column 3, lines 59-64 can be used to point and reposition a screen cursor without physical movement of the mechanical mouse button.

5. Claims 13, 14, 20, 23 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,424,338 to Anderson.

In reference to claims 13, 14 and 20, Anderson in figure 1C teaches an auxiliary computer keyboard, wherein said auxiliary computer keyboard comprises a keyboard housing, said keyboard housing comprising at least one mechanical mouse button – when pressure is applied the mechanical mouse button moves(24 and 26), mounted in said keyboard housing, and at least one touch pad mounted (12) in said keyboard housing, said mechanical mouse button capable of independent movement relative to said keyboard housing to invoke a highlighting mode without physical movement of said keyboard housing (column 9, lines 27-40). The keyboard mouse manipulates and relocates a screen cursor without physical movement or repositioning of said keyboard housing or said mechanical mouse button (column 9, lines 5-9).

In reference to claims 23 and 32, Anderson also anticipates independent claim 6. Anderson teaches an auxiliary computer mouse (figure 1C), wherein said auxiliary computer

Art Unit: 2675

mouse comprises a computer mouse housing supporting at least one mechanical mouse button (24 and 26), and at least one (separate from the mouse button) touch pad (12), said mechanical mouse button being movably mounted within said mouse housing and capable of independent movement relative to said mouse housing to invoke a highlighting mode without physical movement of said mouse housing (column 9, lines 27-40 and 5-9). And finally it is apparent from figure 1C that the mouse is in a keyboard housing.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 9, 11 and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau.

In reference to claims 8 and 9 Lau does not teach the use of a press and lock button or the use of a sliding panel button. However, one skilled in the art understands specific types of mouse buttons are design substitutions common to the mouse art. It would have been obvious to one skilled in the art to use a press and lock button or a sliding panel button as the preferred embodiment if such substitutions improve the ergonomics or the user-friendliness of Lau's invention.

In reference to claims 11 and 30, Lau does not teach the incorporation of a touch pad in the sidewall of the mouse housing, however there is no disclosed criticality for such a limitation. One skilled in the art understands that the location of touch pads is a design specification in the mouse art. It would have been obvious to one skilled in the art to place the touch pad on a sidewall to improve on the ergonomics or the user-friendliness of Lau's invention.

8. Claims 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson

In reference to claims 15 and 16 Anderson does not teach the use of a press and lock button or the use of a sliding panel button. However, one skilled in the art understands specific types of mouse buttons are design substitutions common to the mouse art. It would have been obvious to one skilled in the art to use a press and lock button or a sliding panel button as the preferred embodiment if such substitutions improve the ergonomics or the user-friendliness of Lau's invention.

In reference to claims 18 and 19, Anderson does not teach the incorporation of a touch pad in the sidewall of the mouse housing, however there is no disclosed criticality to such a limitation. One skilled in the art understands that the location of touch pads is a design specification in the mouse art. It would have been obvious to one skilled in the art to place the touch pad on a sidewall to improve on the ergonomics or the user-friendliness of Anderson's invention.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Logan.

In reference to claim 17, Anderson's invention is similar to the one being claimed, however his invention does not teach the specific idea of where the touch pad is integrated into a cavity opening formed in said at least one mechanical mouse button.

Logan on the other hand teaches a touch pad system that is integrated into a cavity opening formed in the a mechanical button.

It would have been obvious to one skilled in the art to add Logan's touch pad system into Anderson's keyboard because as Logan explains in column 1, line 65- column 2, line 10, his improvement allows for superior cursor manipulation with respect to dragging. The two inventions are combined by simply replacing Anderson's existing touch pad with Logan's touch pad. If the applicant argues that combining the two inventions would call for the inclusion of a third button, such an argument is anticipated by Anderson column 9, line 35.

Response to Arguments

10. Applicant's arguments, see Repsonse to canal office action, filed 3/16/05, with respect to claims 1-5, 10, 17, 21, 22, 24, 25, 27, 28, 29, 33 and 34 have been fully considered and are persuasive. The remaining claims 6-9, 11-16, 18-20, 23, 26, and 30-32, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is (571)272-7770. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on 571-272-3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2675

Ming-Hun Liu


SUMATI LEFKOWITZ
PRIMARY EXAMINER